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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/770,095      | 02/02/2004  | Carole Jegu Stora    | 59037US002          | 9275             |

32692 7590 02/27/2006

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| EXAMINER |
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PENG, KUO LIANG

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/770,095

Applicant(s)

STORA, CAROLE JEGO

Examiner

Kuo-Liang Peng

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/12/06 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-22, 24-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-22, 24-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/6/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2006 has been entered. Claims 1 and 23 are deleted. Claims 32-34 are added. Now, Claims 2-22 and 24-34 are pending.

2. As mentioned in a prior Office action, the following Office action is based on the term "microsphere filler" being defined in the specification wherein the microsphere filler has a soft skin. (page 9, lines 17-18)

3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 091705).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner is not able to find a basis for a tack no greater than 2.0 grams.

***Claim Rejections - 35 USC § 103***

6. Rejection of Claims 2-22 and 24-31 under 35 USC 103(a) as being unpatentable over Usami (US 5 099 088) in view of De Ridder (EP 971369), optionally further in view of Mastsumoto (US JP 63-280766) is maintained because the rejection is adequately set forth in paragraphs 7-8 of Paper No. 091705. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 12, 2<sup>nd</sup> paragraph), note that clearly Usami's silicone gel is compressed upon closing the two halves of the splicing means as described in col. 4, lines 50-55 and Figure 9.

For Applicants' argument (Remarks, page 12, 3<sup>rd</sup> paragraph), referring to Figure 1, clearly in each half of the splicing means, the exposed-surface area is obviously smaller than the non-exposed-surface (the surface-area of the recess labeled as 6)(i.e., side-surface area).

7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usami in view of De Ridder.

Usami in view of De Ridder, optionally further in view of Matsumoto discloses a method of sealing a sealable device/enclosable container as described in paragraphs 7-8, which is incorporated herein by reference.

Usami is silent on pre-molding the sealant material. However, Usami teaches the desire to fully fill the recess of the splicing means 1 so that when the connection 9 is embedded in the sealant 3, the sealant 3 is pushed away in an amount corresponding to the volume of the connection 9. (col. 4, lines 3-55) Note that upon curing a polymer (i.e., changing from a liquid state to a solid/non-flowable state), typically the volume of the cured polymer will shrink, except for those polymers having spiro, etc. structures that have high structure strain and the strain of which being released upon curing. Since Usami's organosiloxanes do not have such highly strained structure, upon curing, the volume is decreased when

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they are changing from a liquid state to a solid/non-flowable state. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to pre-mold the silicone gel so that the volume of the cured polymers can be well-controlled (i.e., any volume change can be compensated accordingly).

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiotis (US 5 529 508) as evidenced by Dubrow and in view of De Ridder.

The following column and line numbers referring to De Ridder are based on its US equivalent (US 6 194 476).

Chiotis discloses a sealable device where the end of a hollow member is sealed using a sealing member comprising a layer of sealant between two constraining layers. (Figures 1-3, col. 2, line 27 to col. 3, line 20) The sealant material can be a polyorganosiloxane gel. Chiotis is silent on the use of a microsphere filler. However, Chiotis teaches that the sealant material can be the one taught in Dubrow. (col. 3, line 48 and col. 4, line 2) Thus, Dubrow teaches the use of a filler for decreasing the electrical conductivity, thermal conductivity and/or adjusting the density in a sealant comprising a polyorganosiloxane gel. (col. 2, lines 7-15 and col. 4, lines 58-68) As such, Chiotis as evidenced by Dubrow

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does disclose a sealant material comprising a filler for decreasing the **electrical** conductivity, **thermal** conductivity and/or adjusting the **density** thereof. Chiotis as evidenced by Dubrow is silent on the specific use of a microsphere filler. However, De Ridder teaches the use of a silicone gel containing a hollow compressible filler in a sealant material. The motivation of using the hollow compressible filler is to afford a sealant material with excellent **electrical** insulation, **thermal** insulation, etc. (col. 1, lines 60-65 and col. 5, line 66 to col. 6, line 6) Furthermore, the use of the hollow compressible filler can certainly lower the **density** of the sealant material. In light of the benefit mentioned, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize De Ridder's hollow compressible filler.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
February 17, 2006

  
Kuo-Liang Peng  
Primary Examiner  
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